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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 25

Serial Number: 08/120303
Filing Date: September 13, 1993
Appellant(s): Jacobs et al.

Joseph Shirtz
For Appellant

EXAMINER'S ANSWER

MAILED

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GROUP 1800

This is in response to appellant's brief on appeal
filed 12/19/94.

It is noted that the brief had not been entered at the time
of mailing of the Notice of Allowance and Notice of Dismissal of
Appeal, paper no. 24. Accordingly, the Notice of Allowance and
Dismissal of Appeal are hereby withdrawn.

(1) *Status of claims.*

The statement of the status of claims contained in the brief
is correct.

(2) *Status of Amendments After Final.*

The appellant's statement of the status of amendments after
final rejection contained in the brief is correct.

(3) *Summary of invention.*

The summary of invention contained in the brief is correct.

(4) *Issues.*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows, resulting from the following New Issues which are presented by this Examiner's Answer:

C) Whether claims 11 and 19-20 are anticipated by Al-Sioufi under 35 USC 102(e).

D) Whether claims 11 and 19-20 are anticipated by, or alternatively made obvious by Fisher Scientific under 35 USC 102(b) and 103, respectively.

E) Whether claims 11 and 19-20 are anticipated by, or alternatively made obvious by Engel ('434) under 35 USC 102(b) and 103, respectively.

(5) *Grouping of claims.*

Appellant's brief includes a statement that claims 17 and 20 do not stand or fall together and provides reasons as set forth in 37 C.F.R. § 1.192(c)(5) and (c)(6).

Appellant's brief includes a statement that claims 11 and 18-19 stand or fall together.

(6) *Claims appealed.*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) *Prior Art of record.*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

| | | |
|-----------|------|--------|
| 3,371,985 | Wyka | 3-1968 |
|-----------|------|--------|

(8) *New prior art.*

New references have been applied in a new ground of rejection in this examiner's answer and are listed below:

| | | |
|-----------|-------|--------|
| 3,730,434 | Engel | 5-1973 |
|-----------|-------|--------|

| | | |
|-----------|-----------|--------|
| 4,675,159 | Al-Sioufi | 6-1987 |
|-----------|-----------|--------|

| | | |
|-----------|-------|--------|
| 3,688,985 | Engel | 9-1972 |
|-----------|-------|--------|

Fisher Scientific Catalogue, 1983, pp. 46C and 47C.

(9) *Grounds of rejection.*

The following ground(s) of rejection are applicable to the appealed claims.

Claim 17 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is considered vague and indefinite in that it fails to clearly set forth the positioning or structural relationship between the second opening and the vessel. Specifically, it is unclear, as claimed, how such a second opening of the vessel would be positioned so as to enable the recited capability of attaching a cartridge while further maintaining the vessel closed to the ambient except through the first recited opening.

Claim 17 is further indefinite in that it positively recites the presence of a known quantity of antimicrobial solution in the vessel and further recites that the same known quantity of antimicrobial solution is contained in a cartridge, the cartridge not forming a positively recited element of the claimed invention. Therefore, the claim raises an ambiguity as to whether or not the antimicrobial solution is contained within the vessel as an element of the claimed invention or, alternatively, is contained in a separate cartridge which is not an element of the claimed invention.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue; and
3. Resolving the level of ordinary skill in the pertinent art.

Claims 11 and 18-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Wyka.

The reasons for this rejection are as fully detailed in page of the previous Office action, paper no. 18.

(10) *New ground of rejection.*

This examiner's answer contains the following NEW GROUND OF REJECTION.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 11 and 19-20 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Al-Sioufi.

Specific reference is made to the disclosure of Al-Sioufi at Figure 1, described at column 7, lines 23-54, disclosing a vessel (20) having a single opening and containing an antimicrobial solution (glutaraldehyde) (23) in a known amount and concentration. The single opening shown by Al-Sioufi clearly provided the capability of enabling attachment of a removable closure cap as is depicted in Figure 1. The same single opening would further have inherently provided the presently recited capability of connecting the opening of the vessel to a lumen by either insertion of the lumen within the opening, analogous to the attachment of the cap (21), or by insertion of the vessel opening into the lumen.

Claims 11 and 19-20 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Fisher Scientific Catalogue (1983).

The referenced catalogue shows a conventional container which is provided with a known volume and concentration of hydrochloric acid. Hydrochloric acid would inherently have constituted an antimicrobial solution. As described above with respect to the device of Al-Sioufi, the single opening of the container of Fisher Scientific clearly provided the capability of enabling attachment of a removable closure cap as is depicted in the Figure and would further have inherently provided the presently recited capability of connecting the opening of the container to a lumen by either insertion of the lumen within the opening or by insertion of the vessel opening into the lumen.

Claims 11 and 18-20 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Engel ('434).

Engel discloses a volatilizing device which comprises, referring to Figure 2 thereof, a vessel (11) having a single opening, screw threads (15) about the opening for attachment of a removable closure cap, and an impregnated wick (16) within the container, the wick having been impregnated with an antimicrobial solution (column 3, lines 51-60). With respect to the presently claimed limitation that the antimicrobial solution is present in

a known quantity, it is noted that Engel ('434) specifically refers to and incorporates by reference a co-pending application, issued as U.S. Patent 3,688,985, for a description of the specific steps of impregnating the wick. The incorporated patent, at the paragraph bridging columns 3 and 4, indicates that the volatile matter is provided to the wick in a formulation having known quantity and concentration.

Alternatively, in the event that the specific formulations as taught by the incorporated disclosure were interpreted as falling short of positively teaching that the solution was present in a known quantity, it would have been obvious to one of ordinary skill in the art to determine the actual quantity of material impregnated in order to ensure uniformity and quality control assurance during the manufacturing stages.

It is noted that the multiple new grounds of rejection set forth above have been applied to indicate the extreme breadth of the instant claims. For example, it would appear that a vial of antibiotic medication, as would typically be dispensed by a pharmacist to a patient, would be precluded by the instant invention as claimed.

(11) *Response to argument.*

Appellant traverses the rejection of claim 17, under 35 USC 112, second paragraph, on the grounds that the claim is directed to the embodiments shown in Figure 1 or 2A of the specification, such figures showing a second opening to which an antimicrobial containing cartridge is attached. The attachment of the cartridge provides the recited result of the device being open to the ambient through the first opening only. This argument is not persuasive for the following reasons. Instant claim 17 fails to positively recited the noted cartridge as an element of the invention. Therefore, the recited condition of being closed to the ambient except through the first opening (i.e. that to which the lumen is to be connected) would be required in the absence of the noted cartridge. Furthermore, the claim recites the invention as comprising a vessel which includes a known quantity of antimicrobial solution. The Figures relied upon by Appellant in the argument depict the container (14 and 47, respectively) as forming such vessel rather than the adaptor to which such vessel is to be attached. Therefore, the noted Figures fail to cure the deficiencies of the claim language because they fail to depict a vessel which (i) contains the antimicrobial solution and (ii) includes two openings, only one of which being open to the ambient.

Appellant traverses the rejection of claims 11 and 18-19 as being obvious in view of Wyka on the grounds that the device of

Wyka requires an additional opening to the ambient (through supply hose (6)) which is precluded by the instant claims. This argument is not persuasive because Wyka teaches the provision of a unidirectional valve mechanism (82) covering what Appellant has referred to as the additional opening and a spring biased valve mechanism (60) covering the openings at the opposite end of the cartridge device. As such, under conditions outside of the specific operation of the apparatus of Wyka, e.g. during or following manufacture of the vaporizer device itself, the openings at the left end of the device depicted in Figure 3 would have been occluded and the opening at the right end would have been open to the ambient upon insertion of a suitably sized lumen. Note that Wyka in fact contemplated the vaporizer device itself as constituting an invention, separate from the overall apparatus which included the vacuum system, as is evidenced by claim 3 thereof.

Appellant further argues at page 6 of the brief that Wyka fails to specifically state that the solid crystals are present in a predetermined quantity. However, it would have been obvious to one of ordinary skill in the art to predetermine the actual quantity of material provided in order to ensure uniformity and quality control assurance during the manufacturing stages.

Appellant further argues at page 7 of the brief that Wyka is directed to disinfection rather than sterilization and that disinfection would have required only the reduction of pathogens

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rather than a significant amount of kill of sporicidal entities. Appellant then suggests that this difference indicates that the Wyka device would not have required one to know the quantity of disinfecting vapor provided. However, both disinfection and sterilization involve the destruction to some degree of microorganisms, and as such, the disinfectant or sterilant employed would have constituted an antimicrobial agent. Furthermore, the fact that disinfection constitutes a microorganism kill to a lesser degree than that of sterilization renders the former procedure no less quantitative than the latter in that one of ordinary skill would have desired quantitative knowledge of the effectiveness in either case.

Appellant further argues at pages 7-9 of the brief that the invention recited in instant claim 20 is intended for a purpose which is different from that of Wyka. This argument is not persuasive because the intended use of the device fails to impart patentability to the device itself, where the structure of such device is made obvious in the prior art. Furthermore, it is noted that the vaporizer device of Wyka does not included the vacuum hoses as permanent structure as is evidenced by claim 3 thereof. Furthermore, the fact that the openings of Wyka are capable of connection to the vacuum hoses clearly establishes such openings as being capable of connection to a lumen, since the hoses themselves would have constituted lumens.

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(12) Period of response to new ground of rejection.

In view of the new ground of rejection, appellant is given a period of TWO MONTHS from the mailing date of this examiner's answer within which to file a reply to any new ground of rejection. Such reply may include any amendment or material appropriate to the new ground of rejection. Prosecution otherwise remains closed. Failure to respond to the new ground of rejection will result in dismissal of the appeal of the claims so rejected.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



JEFFREY R. SNAY
PRIMARY EXAMINER
GROUP 1800

2/17/95

jrs
February 17, 1995